

**LUNA** Moda  
120 Landing Ct. Ste A  
Novato, CA 94945

**TTAB**

February 23, 2006

**Via First Class Mail Post Office to Addressee**

BOX TTAB NO FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Re: Opposition No. 91168773**

Dear Sir/Madam,

Transmitted herewith is:

- 1) A formal Answer in the above opposition
- 2) A Motion to Suspend Proceedings of the above opposition

Copies of the above were sent via first class mail to the Attorney of the Opposer.

Thank you for your assistance in this matter.

Sincerely,



Melissa Gygax  
Vice-President  
Luna Moda, Inc.  
Applicant



02-27-2006

U.S. Patent & TMOfo, TM Mail Rcpt Dt. #30



Opposer has attached copies of the registrations to the Notice of Opposition. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of Paragraph 2 and therefore denies the same.

3. Answering Paragraph 3 of the Notice of Opposition, Applicant denies the allegations in Paragraph 3.

4. Answering Paragraph 4 of the Notice of Opposition, Applicant admits the allegations contained in Paragraph 4.

5. Answering Paragraph 5 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of Paragraph 5 and therefore denies the same.

6. Answering Paragraph 6 of the Notice of Opposition, Applicant denies the allegations in Paragraph 6.

7. Answering Paragraph 7 of the Notice of Opposition, Applicant denies the allegations in Paragraph 7.

8. Answering Paragraph 8 of the Notice of Opposition, Applicant denies the allegations in Paragraph 8.

9. Answering Paragraph 9 of the Notice of Opposition, Applicant denies the allegations in Paragraph 9.

#### **AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

2. On information and belief, independent third-parties have frequently used, applied for, and registered marks which comprise and/or incorporate the word "JAM" or

variants thereof, particularly in the clothing industry. The following represents a non-exclusive list of such registrations, applications, and uses:

- a. GLO-JAMA, for children's clothing, namely, warm-up suits, sweat suits and sleepwear. (US Reg. No. 1360744)
- b. P. JAMAS, for sleepwear (US Reg. No. 2462615)
- c. P-JAMS BY VARSITY, for sleepwear and loungewear (US Reg. No. 1443312)
- d. JAMWEAR, for clothing, namely, work uniforms for business and government employees in the nature of shirts, jackets, coats, pants, shorts, dresses and skirts. (US Reg. No. 2931095)
- e. ROOTS JAM, for clothing, namely, hats, caps, t-shirts, shorts, sweatshirts, sweatpants, pants, visors and wrist bands (US Reg. No. 2928075)
- f. ESLEEP JAMMIES, for apparel, namely, pajamas, nightshirts, underwear, shorts, tops, and T-shirts (US Reg. No. 2198970)
- g. JOLLY JAMS, for infant and toddler pajamas and sweat suits. (US Reg. No. 2377071)
- h. CULTURE JAM, for men's ladies' and children's pants, shorts, jeans, overalls, skirts, shirts, jackets, vests, dresses, sweat pants, and sweatshirts. (US Reg. No. 2578876)
- i. RUGGED JAM, for clothing, namely, headwear, footwear, shirts, t-shirts, vests, trousers and jackets. (US Reg. No. 2975565)
- j. CALIFORNIA JAM, for career oriented women's sportswear, namely, jackets, pants, skirts, and blouses. (US Reg. No. 1521907)
- k. FRENCH JAM, for shoes (US Reg. No. 1410648)
- l. PEACEJAM, for shirts, hats, t-shirts, footwear, and bandanas distributed in conjunction with literature, activities and/or events promoting an awareness of the lives and works of Nobel Peace Prize Winners (US Reg. No. 2373099)
- m. SLAM CITY JAM, for clothing, namely, pants, shorts, T-shirts, sweatshirts, tank tops, jackets, baseball caps, and toques. (US Reg. No. 2827565)
- n. MOISTURE JAMZZ, for clothing, namely, gloves (US Reg. No. 1751934)
- o. DEF JAM, for clothing, namely, jerseys, uniforms, athletic uniforms, pants, trousers, slacks, jeans, denim jeans, overalls, coveralls, jumpers,

jump suits, shorts, boxer shorts, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, tops, crop tops, tank tops, halter tops, sweatshirts, sweat shorts, sweat pants, warm-up suits, jogging suits, skirts, dresses, sweaters, vests, fleece vests, pullovers, fleece pullovers, parkas, anoraks, ponchos, jackets, dinner jackets, sports jackets, golf and ski jackets, reversible jackets, coats, blazers, turtlenecks, swimwear, beachwear, caps, hats, headbands, wrist bands, headwear, bandanas, belts, underwear, briefs, trunks, socks, loungewear and rainwear. (US Reg. No. 3015901)

- p. PEARL JAM, for clothing, namely, T-shirts, hats, tank tops (US Reg. No. 1911524)
- q. GYM JAM, for clothing, namely, t-shirts, tank tops, sweat pants, sweatshirts, hats, jackets, socks, pants, boxer shorts, pajamas, leotards, Spandex shorts and leggings. (US Reg. No. 2751609)
- r. SPACE JAM, for clothing for men, women, and children, namely, shirts, T-shirts, sweatshirts, jogging suits, trousers, jeans, shorts, tank tops, rainwear, bibs, skirts, blouses, dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sunvisors, clothing belts, scarves, sleepwear, pajamas, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear, and costumes comprised of body suits and face mask (US Reg. No. 2082189)
- s. PLAY-JAMA, for pajama-playsuit combination garment for children (US Reg. No. 0903672)
- t. NINJAMMIES, for clothing, namely, sleepwear (US Reg. No. 1412455)
- u. MY JAMMIES, for children's pajamas (US Reg. No. 3021767)
- v. JIM JAMAS, for pajamas (US reg. No. 1028009)
- w. COUNTRY JAM, USA, for shirts, hats, coats, and shoes. (US Reg. No. 1932498)
- x. BEES & JAM, for nightgowns, dorm shirts, pajamas, robes, loungewear, panties, T-shirts, shorts. (US Reg. No. 1284388)
- y. JERSEY JAMS, for bed sheets and pillow cases made in whole or significant part of jersey knit (US Reg. No. 2272961)
- z. PAJAMA JAMMIE JAM, for loungewear, namely, pajamas. (US Reg.No. 1786195)

3. Concurrent use of the numerous pending registrations and registrations of marks comprising or utilizing "JAM" and variants in the clothing industry –and other general categories- has conditioned the public to distinguish between the various uses of the

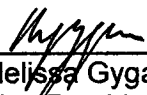
word "JAM" or variants thereof based on slight differences in the marks and/or differences in the products. Accordingly, the marks JAMS and JAMS FAST are not sufficiently strong or distinctive to prevent use or registration of the distinct mark STREETJAMAS.

4. Opposer does not have the exclusive right to use the term "JAM".

In view of the foregoing, Applicant contends that this opposition is groundless; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from alleged marks of Opposer and Applicant prays that this Opposition be dismissed and that Applicant be granted registration of trademark.

Respectfully submitted,


Dated: February 23, 2006

By:   
Melissa Gygax  
Vice-President  
Luna Moda, Inc.  
120 Landing Court, Ste B  
Novato, CA 94945  
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email: melissa@lunamoda.com

**Certificate of Service**

This is to certify that I, Melissa Gygax, today, served the above **ANSWER AND AFFIRMATIVE DEFENSES** on the Opposer by first-class mail, postage prepaid, addressed to Megan E. Gray, Roylance, Abrams, Berdo & Goodman LLP, Attorney for Opposer Surf Line Hawaii Ltd, 1451 Kalani Street, Honolulu, HI 96817.

Dated: February 23, 2006

By:   
Melissa Gygax  
Vice-President  
Luna Moda, Inc., Applicant

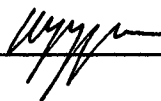
**Certificate of Mailing**

Delivery confirmation number: 0303 2460 0002 5171 9874.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Trademark Trial and Appeal Board, Commissioner of Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on 2/23/2006.

Date

Signature



Melissa Gygax

Typed or Printed Name of Person Signing Certificate

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SURF LINE HAWAII, LTD.,	)	
	)	
Opposer,	)	
	)	
v.	)	Proceeding No. 91168773
	)	
LUNA MODA, Inc,	)	
	)	
Applicant.	)	

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**MOTION TO SUSPEND PROCEEDINGS**

Luna Moda, Inc., ("Applicant") in the state of California, hereby moves the Trademark Trial and Appeal Board to suspend this proceeding, Opposition No. 91168773, until termination of Proceeding No. 91168254 ('the other proceeding'), under 37 C.F.R. § 2.117 (a).

37 C.F.R. § 2.117 (a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

Applicant brings to the attention of the Trademark Trial and Appeal Board that Surf Line Hawaii Ltd , Opposer is a party to a pending case and is engaged in another Board proceeding.



This 'other Board proceeding' No. 91168254, will have direct bearing on the case of Opposition No. 91168773. Applicant believes these facts constitute grounds for the Board to suspend the proceedings of Opposition No.91168773 until termination of No.91168254 under 37 C.F.R. § 2.117 (a).

**Background of No. 91168254 ('other Board proceeding')**

Surf Line initiated Proceeding No. 91168254 seeking to deny U.S. registration of the mark MONSTER JAM, Serial No. 78360292, by SFX Motor Sports.

In his answer to the Opposition, SFX Motor Sports counterclaimed, seeking cancellation of Surf Line's U.S. registrations Nos. 1497797, 920266, and 1537352 for the mark JAMS based on the fact that "JAMS" is a generic term used by the public to describe items of leisure wear, particularly, shorts and swimming trunks, and is incapable of functioning as a trademark for said items.

Proceeding No. 91168254 remains before the Board.

**Basis for Motion to Suspend this Proceeding (No. 91168773)**

The Registrations Nos. 920266, 1497797, and 1537352 of Opposer JAMS, are the basis of Opposition No. 91168773, where Opposer Surf Line, opposes registration of Applicant's mark STREETJAMAS, Serial No. 78467852.

The 'other Board proceeding' No. 91168254, was initiated in December 23, 2005. This Opposition No. 91168773 was initiated January 23, 2006. Both proceedings remain before the Board.

Surf Line is the 'party' engaged in the 'other Board proceeding' No. 91168254. Surf Line is also the very same 'party' engaged in this Opposition No: 91168773.

Cancellation of JAMS in proceeding No. 91168254 will have direct bearing on this case, Opposition No. 91168773.


Under 37 C.F.R. § 2.117 (a), Applicant hereby brings to the attention of the Trademark Trial and Appeal Board that the Opposing party is engaged in another Board proceeding which remains before the Board and which will clearly have a bearing on the case of Opposition No. 91168773.

Applicant respectfully moves the Board to suspend this proceeding, Opposition No. 91168773, until termination of the 'other Board proceeding', Proceeding No. 91168254.

Dated: February 23, 2006

Respectfully submitted,

By: \_\_\_\_\_

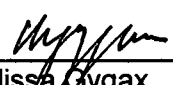
  
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Dated: February 23, 2006

By: \_\_\_\_\_

  
Melissa Gygax  
Vice-President  
Luna Moda, Inc., Applicant

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Date

Signature



Melissa Gygax

Typed or Printed Name of Person Signing Certificate